



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,278	11/22/2000	Michelle Q. Wang Baldonado	1508-3170	2069

7590 03/15/2005

Gunnar G Leinberg Esq
Nixon Peabody LLP
Clinton Square
P O Box 31051
Rochester, NY 14603

EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/717,278	Applicant(s) WANG BALDONADO ET AL.	
	Examiner Victor Lesniewski	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 10/13/2004 has been placed of record in the file.
2. Claims 1, 3, 7, 10, 13, 16, 19, and 20 have been amended.
3. The objection to the drawings is withdrawn in view of the amendment.
4. The objection to the specification is withdrawn in view of the amendment.
5. The rejection of claims 19 and 20 under 35 U.S.C. 112 is withdrawn in view of the amendment.
6. Claims 1-20 are now pending.
7. The applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the following new grounds of rejection.

Response to Amendment

8. Claims have been amended to show a determination of a digest for a selected candidate message or delivery of a candidate message based on supplemental selection criteria. The amendment proves a change in scope to the independent claims as the independent claims now explicitly state determining for each of the candidate messages which of one or more digests is appropriate. However, none of the amended claims show a patentable distinction over the prior art as evidenced by the following new grounds of rejection.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2155

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Summers

(U.S. Patent Number 6,816,884) in view of Canale et al. (U.S. Patent Number 5,619,648),

hereinafter referred to as Canale.

11. Summers disclosed a system that selectively filters email messages and creates a digest to be delivered to users. In an analogous art, Canale disclosed various techniques for filtering email messages. Both systems are focused on email filtering methods.

12. Concerning claims 1, 7, 13, and 19, Summers did not explicitly state the use of a sender-independent message-based rule when selecting a candidate message. Summers does discuss the use of sender-independent message-based rules in his system, but his system does check the sender of the message when it operates on an original candidate message. However, email filtering rules that are sender-independent are well known in the art as evidenced by Canale. Canale explicitly discloses filtering based on a sender-independent message-based rule when receiving the message from the network. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Summers by adding the ability to select one or more candidate messages from a plurality of electronic messages based on one or more sender-independent message-based rules as provided by Canale. Here the combination satisfies the need for a system that simplifies a sender's and a recipient's use of discussion groups by providing flexibility in filtering email messages. See Summers, column 2, lines 25-33. This rationale also applies to those dependent claims utilizing the same combination.

Art Unit: 2155

13. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a method, an information storage media, or an alternative system are rejected under the same rationale applied to the described claim.

14. Thereby, the combination of Summers and Canale discloses:

- <Claims 1, 7, 13, 19, and 20>

An electronic message management system comprising: an information selection device that selects one or more candidate messages from a plurality of electronic messages based on one or more sender-independent message-based rules; and an electronic message management device that determines for each of the candidate messages which of one or more digests is appropriate and integrates each of the candidate messages into the digest determined to be appropriate or selects one or more of the candidate messages which meet one or more supplemental selection criteria. (Summers, column 12, lines 40-64 and Canale, column 2, lines 11-18).

- <Claims 2, 8, and 14>

The system of claim 1, further comprising a digest management device that delivers the digest to a predetermined destination upon satisfaction of at least one of the one or more sender-independent message-based rules (Summers, column 12, lines 13-25).

- <Claims 3, 10, and 16>

The system of claim 1, further comprising an information sampling device that delivers the selected candidate messages to a predetermined destination based on one or more of the sender-independent message-based rules (Summers, column 12, lines 13-25).

Art Unit: 2155

- <Claim 4>

The system of claim 1, further comprising a rule management device that manages the one or more sender-independent message-based rules (Summers, figure 3, item 33A).

- <Claims 5, 11, and 17>

The system of claim 1, wherein the one or more sender-independent message-based rules include a Boolean comparison, a statistical-based selection criteria, a fuzzy logic based selection criteria, a keyword based selection criteria, a date, a subject, a recipient, or a sender-based selection criteria (Canale, column 2, lines 11-18).

- <Claims 6, 12, and 18>

The system of claim 1, wherein the electronic message is at least one of an email, an electronic message from a mailing list, and a bulletin board posting (Summers, column 3, lines 26-32).

- <Claims 9 and 15>

The method of claim 7, further comprising determining and updating the digest based on one or more of the sender-independent message-based rules (Summers, column 13, lines 20-26).

Since the combination of Summers and Canale discloses all of the above limitations, claims 1-20 are rejected.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

Art Unit: 2155

- Kudoh et al. (U.S. Patent Number 5,948,058) disclosed a method for cataloging and displaying email using multiple categories or classification types based on email object information.
- McCormick et al. (U.S. Patent Number 6,023,723) disclosed a method for filtering junk emails using two consecutive filters that operate on a list of email addresses or character strings.
- Shaw et al. (U.S. Patent Number 6,249,807) disclosed an enterprise email management system that uses a set of configurable rules to process incoming emails for specific attribute state conditions.

16. The applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2155

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor Lesniewski
Patent Examiner
Group Art Unit 2155



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER